



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,110	12/20/2001	Jill Cheng	3420.1	7433

22886 7590 03/02/2006

AFFYMETRIX, INC
ATTN: CHIEF IP COUNSEL, LEGAL DEPT.
3420 CENTRAL EXPRESSWAY
SANTA CLARA, CA 95051

EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/026,110

Applicant(s)

CHENG, JILL

Examiner

Marjorie A. Moran

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 09 February 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-7, 13-22, 28-37 and 43-45.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Marjorie A. Moran
2/21/06

Marjorie A. Moran
Primary Examiner
Art Unit: 1631

Continuation of 3. NOTE: the limitation for outputting results of an analyzing step is a new issue requiring further search and consideration.

Continuation of 11. does NOT place the application in condition for allowance because: the arguments with regard to statutory and utility rejections under 35 USC 101 are directed to the amended claims. As the amendment has not been entered, the arguments are not persuasive. In order to further prosecution, however, it is noted that a step of outputting results of an analyzing step would not represent a concrete, tangible and useful result for the claimed method as it would not be clear what those results ARE; i.e. the output, while tangible, would not be concrete or useful as one would not know what the results relate to. For example, do the results of the proposed claims indicate some connection between expression levels and a biological characteristic, or are the results merely a listing of data without any discernable pattern or connection between data elements?

In response to arguments with regard to the prior art rejections under 35 USC 103, it is noted that limitations argued by applicants are not found in the claims. Specifically, claim 1 does not recite analyzing expression levels according to at least one biological characteristic based on gene ontology, as argued on page 10 of the response. Rather, claim 1 recites selecting a biological characteristic from a database wherein the characteristics in the database ARE DESCRIBED by gene ontology. The third step of analyzing expression levels limits the analyzing to be "according to" at least one biological characteristic. Thus, while the biological information IN THE DATABASE is correlated to gene ontology, the analysis is NOT limited to be affected by or otherwise take into account anything with regard to gene ontology. In response to applicant's argument that ZHENG does not teach selection of a biological characteristic, it is noted that page 7 of the last office action set forth that ZHENG clustered expression data according to a biological characteristic. The tissue origin and genomic information taught by ZHENG as "characteristics" are certainly biological in nature. as the arguments with regard to ZHENG are not persuasive, the arguments with regard to combinations of references including ZHENG are also unpersuasive. Applicant argues only that GARNER does not teach or suggest analyzing gene expression levels according to a biological characteristic BASED ON GENE ONTOLOGY. As set forth above, the claims do not recite this limitation, therefore the argument is not persuasive.

Continuation of 13. Other: The IDS filed 2/9/06 has not been considered as it does not comply with the requirements of 37 CFR 1.97 (e).